UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,402	11/10/2000	Peter Paul Polit	RCA88820	1656

24498 7590 02/22/2007	EXAMINER	
JOSEPH J. LAKS, VICE PRESIDENT	LY, ANH VU H	
THOMSON LICENSING LLC		
PATENT OPERATIONS	ART UNIT	PAPER NUMBER
PO BOX 5312		
PRINCETON, NJ 08543-5312	2616	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/582,402	POLIT ET AL.
	Examiner	Art Unit	
	Anh-Vu H. Ly	2616	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 November 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5 and 7-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5 and 7-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This communication is in response to applicant's amendment filed November 27, 2006.

Claims 1-5 and 6-20 are pending.

Claim Objections

2.   Claims 16 and 17 are objected to because of the following informalities:

With respect to claim 16, in line 1, replace "called ID information" with --caller ID

information--.

With respect to claim 17, in line 1, replace "said IP network connection" with --said

second connection--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1-5 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Oyama et al (US Patent No. 6,108,329) in view of Fan (US Patent No. 6,636,506 B1).

Hereinafter, referred to as Oyama and Fan.

With respect to claims 1, 14, and 15, Oyama discloses a method for setting up a voice call

over Internet (Fig. 6) comprising the steps of:

initiating an Internet voice call to a called device (col. 6, lines 53-56, the terminal T11

sends a call request to the server S11 having a desired destination address);

determining whether the called device is already connected to the Internet (col. 7, lines 3-

6, the server S21 of the computer network NET21 dials the telephone number of the terminal

T21 obtained from the database DB21 to call up the terminal T21. Herein, the server S21

already determined that the terminal T21 is not already connected to the server; otherwise, the

server would not dial the terminal T21);

initiating a first connection by placing a PSTN telephone call with associated caller ID

information to the called device, if the called device is not already connected to the Internet (col.

9, lines 42-45 and Fig. 11B, at step 23, the destination terminal obtains information on the

origination terminal ST23 when the server S21 dials the telephone number of the terminal T21,

considered as a first connection. Wherein, the information on the source terminals may include

names of the source terminals, countries of the source terminals, dates and times of dispatch,

dates and times of arrival, and so forth);

establishing said Internet voice call with the called device in response to the associated

caller ID information (Fig. 11B, at step 28, communication through Internet).

Oyama does not disclose connecting to the Internet by initiating a second connection

through a data network. The second connection is different from the first connection and is made

after first connection made through the PSTN terminated. Fan discloses that after the second

station exchanges caller's telephone number, name, etc... the second station hangs up thus

breaking PSTN connection. Following the disconnect PSTN connection, second station dials its

ISP and establishes a TCP/IP connection for beginning a voice communication over Internet (col.

4, lines 21-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to dial an ISP for starting an Internet connection after exchanging information via PSTN connection in Oyama's system, as suggested by Fan, thereby any pre-arrangements can be made between the two parties.

With respect to claims 2, 9, and 12, Oyama discloses that wherein the associated caller ID information is a predetermined caller ID number and/or type I caller ID information (col. 9, lines 42-45, the information on source terminals may include names of the source terminals, countries of the source terminals, dates and times of dispatch, dates and times of arrival, and so forth. Herein, normally, all caller ID information is considered as type I caller ID information).

With respect to claims 3 and 17, Oyama discloses a method for setting up an IP voice call through an IP network (Fig. 6), comprising the steps of:

initiating an IP voice call to a called device (col. 6, lines 53-56, the terminal T11 sends a call request to the server S11 having a desired destination address);

determining whether the called device is already connected to the IP network (col. 7, lines 3-6, the server S21 of the computer network NET21 dials the telephone number of the terminal T21 obtained from the database DB21 to call up the terminal T21. Herein, the server S21 already determined that the terminal T21 is not already connected to the server; otherwise, the server would not dial the terminal T21);

initiating a first connection by placing a PSTN telephone call with a distinctive ringing pattern to the called device, if the called device is not already connected to the Internet (col. 8,

lines 56-58, a call through the modem and a call through a usual telephone can be discriminated

by receiving a European calling tone from a server, considered as a first connection);

establishing said IP voice call with the called device in response to said distinctive

ringing patterns (Fig. 11B, at step 28, communication through Internet).

Oyama does not disclose connecting to the IP network by initiating a second connection

via said IP network. The second connection is different from the first connection and is made

after first connection terminated. Fan discloses that after the second station exchanges caller's

telephone number, name, etc... the second station hangs up thus breaking PSTN connection.

Following the disconnect PSTN connection, second station dials its ISP and establishes a TCP/IP

connection for beginning a voice communication over Internet (col. 4, lines 21-42). It would

have been obvious to one having ordinary skill in the art at the time the invention was made dial

an ISP for starting an Internet connection after exchanging information via PSTN connection in

Oyama's system, as suggested by Fan, thereby any pre-arrangements can be made between the

two parties.

With respect to claim 4, Oyama discloses that wherein the distinctive ringing pattern is

different from the ringing pattern of a regular PSTN telephone call (col. 8, lines 56-58, a call

through the modem and a call through a usual telephone can be discriminated by receiving a

European calling tone from a server).

With respect to claims 5, 18, 19, and 20, Oyama discloses a method for receiving an IP

voice call for a receiving device (Fig. 6), comprising the steps of:

receiving an IP voice call through an IP network, if the receiving device is connected to

the IP network (Fig. 7, a communication between the origination terminal and destination

terminal begins immediately if the destination terminal already connected to the Internet);

connecting the device to the IP network (Fig. 7) in response to:

a. receiving a PSTN telephone call comprising at least one of a distinctive ringing pattern

and a caller ID information through a PSTN line, said received PSTN telephone call being a first

data connection which is terminated after receiving at least one of said distinctive ringing pattern

and caller ID information (col. 9, lines 42-45 and Fig. 11B, at step 23, the destination terminal

obtains information on the origination terminal ST23 when the server S21 dials the telephone

number of the terminal T21, considered as a first connection. Wherein, the information on the

source terminals may include names of the source terminals, countries of the source terminals,

dates and times of dispatch, dates and times of arrival, and so forth);

b. comparing the received caller ID information with a predetermined caller ID

information, when caller ID information is received (Fig. 12);

c. establishing the IP voice call in response to at least one of the distinctive ringing

pattern (col. 7, lines 7-11,the destination terminal T21 sends back an acknowledgment,

considered as a second connection) and if the received caller ID information matches the

predetermined caller ID information (Fig. 11B, step 28).

Oyama does not disclose initiating a second data connection by connecting to the IP

network as to establish a voice call. The second connection is different from the first connection

and is made after first connection through the PSTN terminated. Fan discloses that after the

second station exchanges caller's telephone number, name, etc... the second station hangs up

thus breaking PSTN connection. Following the disconnect PSTN connection, second station dials its ISP and establishes a TCP/IP connection for beginning a voice communication over Internet (col. 4, lines 21-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made dial an ISP for starting an Internet connection after exchanging information via PSTN connection in Oyama's system, as suggested by Fan, thereby any pre-arrangements can be made between the two parties.

With respect to claims 7 and 10, Oyama discloses that wherein said caller ID information is associated with a device initiating the method (col. 9, lines 42-45, the information on the source terminals may include names of the source terminals, dates, and so forth).

With respect to claims 8 and 11, Oyama discloses that wherein said device initiating said method is a server that operates between a caller device and said called device (Fig. 6, server S11).

With respect to claims 13 and 16, Oyama discloses that wherein a distinctive ringing pattern is used with said caller ID information for establishing an Internet voice call to said called device (col. 3, lines 36-42).

Response to Arguments

4.   Applicant's arguments with respect to claims 1-5 and 7-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Anh-Vu H. Ly whose telephone number is 571-272-3175. The

examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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